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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,605	03/20/2002	Jean-Marc Frances	022701-968	4221
21839	7590	08/18/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			BERMAN, SUSAN W	
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1711

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	Application No. 10/009,605	Applicant(s) FRANCES ET AL.	
	Examiner Susan W Berman	Art Unit 1711	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 23 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
**ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☐ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): see attached pages.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached pages.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: 7

Claim(s) rejected: 1-6, 8-11

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_  
10. ☐ Other: \_\_\_\_\_

Susan W Berman  
Primary Examiner  
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**DETAILED ACTION**

See 37 CFR 1.193(a)(2) which provides for the inclusion of the proposed rejection(s) detailed below in the Examiner's Answer if applicant elects to file an appeal to the Board of Patent Appeals and Interferences in this proceeding. To be complete, such rejection(s) must be addressed in any brief on appeal.

Upon appeal and entry of the amendment:

Claims 1- 11 would be rejected for the reasons set forth in **pages 3, paragraphs (3) and (5), to page 5** of the final Office Action mailed 01-23-2004. To clarify the rejection under 35 USC 112 set forth in paragraph (5), it is the examiner's position that component "C" in the instant claims should be limited to compounds nonorganosilicone compounds "C<sub>1</sub>" and organosilicone compounds "C<sub>2</sub>" as defined in the specification on pages 35-36. With respect to the rejection under 35 USC 112 in paragraph (3) applicant proposes in the amendment after final rejection to change oniu7m salts to onium cations, but has not changed the recitations of oxoisothiochromanium 'salts', sulfonium "salts" or organometallic "salts" to "cations".

***Response to Arguments***

Applicant's arguments for reconsideration of the rejection of claims under 35 USC 103(a) are found unpersuasive for the following reasons.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, FR '870 discloses compositions comprising

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epoxy-functional silicones and iodonium salt catalysts while EP '703 teaches compositions comprising epoxy-functional silicones, iodonium salts and an epoxy-functional reactive diluent. Since FR '870 discloses using an iodonium salt catalyst and EP '703 teaches that a reactive diluent comprising an organic phenol and an epoxy functional organic compound provides greater miscibility with epoxy silicone polymers, improved shelf stability and greater UV cure efficiency, it is the examiner's position that One of ordinary skill in the art at the time of the invention would have been motivated to employ the reactive diluent taught by EP '703 to take advantage of the improved photocatalyst compositions taught by EP '703. Applicant's claims, except for claim 7, comprise compositions wherein the reactive diluent has only one functional group corresponding to the disclosure of EP '703. It is noted that EP '703 does not teach or suggest reactive diluents that are crosslinking agents containing at least two functional groups.

In response to applicant's argument that FR '870 and EP '703 are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, FR '870 is in the field of applicant's endeavor and discloses compositions analogous to the compositions disclosed by EP '703. The teaching of EP '703 to improve the compatibility of an epoxysilicone and an iodonium catalyst, compositions as disclosed by FR '870, is reasonably pertinent to the problem of obtaining a compositions useful for a process for impregnation of coating desired in FR '870.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and

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does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The Declaration under Rule 1.1.32 of Jean Marc Frances submitted 07-23-2004 has been considered. The comparative data presented provides convincing evidence of improvement in solvent resistance and scratch resistance obtained from the compositions employed. The results may be expected as a result of crosslinking the epoxy silicone component with reactive diluent. However, there is no suggestion in FR '870 or in EP '703 that adding an epoxy-functional reactive diluent would improve solvent resistance or scratch resistance of the cured compositions used in the disclosed processes. In any case, the instant claims are not considered to be commensurate in scope with the showing provided for the following reason. The claims set forth that the reactive diluent is a compound having at least one "CFG" and optionally at least one "SFG"; however, the improved resistances are obtained by using a reactive diluent containing at least two functional groups to provide crosslinking upon curing.

Applicant has not addressed the issue of obviousness-type double patenting, therefore, claims 1-6 and 8-11 remain rejected for obviousness-type double patenting.

*Allowable Subject Matter*

Claim 7, written in independent form including all the limitations of claim 1 would be considered patentable over the combination of teachings of FR '870 and EP '703 in view of the comparative evidence of unexpected results provided in the Declaration. The obviousness-type double patenting rejection of claim 7 over US 6,423,378 is also overcome by the evidence in the Declaration submitted 07-23-2004.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Susan W Berman  
Primary Examiner  
Art Unit 1711

SB  
August 17, 2004